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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,560	12/08/2000	Robert Schlegel	MRI-008A	3311

959 7590 10/15/2002

LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON, MA 02109

EXAMINER

SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 10/15/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/732,560

Applicant(s)

SCHLEGEL ET AL.

Examiner

Carolyn L Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821 (a)(1) and (a)(2). See for example, page 27, lines 33-34; Table 8B; and elsewhere. However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825, because it lacks SEQ ID Nos cited along with each sequence in the specification or Tables. Applicants are also reminded that a CD-ROM sequence listing submission may replace the paper and computer readable form sequence listing copies. Applicant(s) are required to submit a new computer readable form sequence listing, a paper copy, or CD-ROM for the specification, statements under 37 CFR § 1.821 (f) and (g). Applicant(s) are given the same response time regarding this failure to comply as that set forth to respond to this office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office Action.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23 and 38, drawn to a method and kit for detecting cervical cancer or a pre-malignant condition, classified in class 436, subclass 64. If this Group is elected then the below summarized sequence election is also required.

- II. Claims 24-30, drawn to a method for monitoring the progression of cervical cancer or a pre-malignant condition, classified in class 436, subclass 64. If this Group is elected then the below summarized sequence election is also required.
- III. Claims 31-37, 39, and 46, drawn to a method and kit of assessing the efficacy of a therapy for inhibiting cervical cancer, classified in classes 514 and 600, subclasses 1 and 1, respectively. If this Group is elected then the below summarized sequence election is also required.
- IV. Claim 40, drawn to a method of making a hybridoma which produces an antibody, classified in class 436, subclass 547. If this Group is elected then the below summarized sequence election is also required.
- V. Claims 41 and 42, drawn to an antibody and kit, classified in class 530, subclass 387.1. If this Group is elected then the below summarized sequence election is also required.
- VI. Claims 43-44, drawn to a method and kit of assessing cervical cell carcinogenic potential of a test compound, classified in class 530, subclass 388.21. If this Group is elected then the below summarized sequence election is also required.
- VII. Claim 45, drawn to treating a patient with cervical cancer, classified in class 514, subclass 44. If this Group is elected then the below summarized sequence election is also required.

**Sequence Election Requirement Applicable to All Groups:**

In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid/polypeptide sequences, the Applicants must further elect a single amino acid/polypeptide sequence. For an elected Group drawn to nucleotide sequences, the Applicants must elect a single nucleic acid sequence (See MPEP 803.04). It is noted that the multitude of sequence submissions of examination has resulted in an undue search burden if more than one nucleic acid sequence is elected, thus making the previous waiver for up to 10 elected nucleic acid sequences effectively impossible to reasonably implement.

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Examination will be restricted to only the elected sequence. It is additionally noted that this sequence election requirement is a restriction requirement and not a specie election requirement.

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The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups [I and II], [III and VI], [IV and V], and [VII] are independent inventions because they are directed to different chemical types regarding the critical limitations therein. For Groups I and II, the critical features are markers without the presence of other bioaffective materials or influences. For Groups III and VI, the critical feature is a therapy, such as a test compound. For Group IV and V, the critical feature is an antibody. For VII, the critical feature is an oligonucleotide. The completely separate chemical and entity types of the invention Groups are often separately characterized and published in literature, thus adding to the search burden if all Groups were examined together. Also, processing that may connect two Groups does not prevent them from being considered distinct because enough processing can result in the production of any composition from another composition as long as the processing is not limited in occurrences such as subtractions, additions, and enzymatic action. Thus, the three Groupings: [I and II], [III and VI], [IV and V], and [VII] are independent and/or distinct invention types for restriction purposes.

Although there are no provisions under the section "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups [I and II] as well as [III and VI] achieve different goals and are not required by any other group. The goal of Group I is to detect cervical cancer or a pre-malignant condition while the goal of Group II is to monitor the progression of cervical cancer or a pre-malignant condition. The goal of

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Group III is to assess efficacy of a therapy, such as a test compound, to inhibit cervical cancer while the goal of Group VI is to assess the carcinogenic potential of a test compound to a cervical cell. While the goals of these Groups differ, it is noted that each Group is also not required for any other Group.

The invention Groups IV and V are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case antibodies of Group V may be utilized in several distinct usages as needed in Group IV for a method of making a hybridoma, or alternatively in preparing T cells. All of these usages are distinct as requiring distinct and different functions thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were searched together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (703) 308-6043. The examiner can normally be reached Monday through Friday from 9 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 7, 2002

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER